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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,935	12/13/2001	Norikazu Ochiai	01823/LH	2660

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EXAMINER

KANG, ROBERT N


ART UNIT

PAPER NUMBER

2622

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/021,935	Applicant(s) OCHIAI, NORIKAZU	
	Examiner Robert N. Kang	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/13/2001</u> . | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

Response to Arguments

1. Regarding claims 1, 2, 6, 13, 14, and 18, rejected under 35 U.S.C. § 102 in view of Corona (US-PAT 5,316,279), the applicant has added the limitation, "wherein page information is printed on the back surface of the sheet in Y/X form, wherein X is a total number of pages in a print job, and Y is a page number of the printed sheet." This feature was previously contained in claims 7 and 19 and rejected under 35 U.S.C. §103. Therefore, the 102 rejection has been withdrawn and replaced with a rejection under 35 U.S.C. §103.

2. Applicant also states on page 13, paragraph 1, that Fujita and/or Microsoft Notepad does not "teach or suggest printing page information on the back surface of a printed sheet in Y/X form, wherein X is a total number of pages in a print job and Y is a page number of the printed sheet, as recited in independent claims 1, 7, 13, and 19." In regards to the Corona patent, applicant states on page 12, paragraph 4, "according to Coronal et al the information such as the number of pages is printed on the cover sheet... the 'number of pages' in Corona et al merely corresponds to the total number of pages (X) according to the claimed present invention." Thus, by the applicant's own admission, Corona teaches printing the page number X on the back of a single page or cover sheet so as to increase the visibility to the user. Microsoft Notepad, as stated, prints the current page number (Y) on each printed page. Therefore, combining Corona and Microsoft Notepad, it follows that the invention would print X and Y on the back of

each page printed. Therefore, Microsoft Notepad does indeed teach the components of the present invention missing from Corona.

3. Because the applicant's reasons for allowability of dependent claims 2-6, 8-12, 14-18, and 20-24 hinge on the above argument, Examiner asserts that meeting the requirements of the added limitations immediately renders previously rejected dependent claims unpatentable.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 7, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corona (US-PAT 5316279) in view of Microsoft Corporation Notepad.

Corona discloses an apparatus and a method of operating the given apparatus for "segregating and identifying separate job sets from a commonly stacked output of plural job sets." Corona states in column 3, lines 7-10, "modern printers, copiers, fax machines, and workstation terminals are now more and more utilized as shared and/or integrated components of overall office systems, in which they are cost-effectively shared by plural users, electronically and/or physically." Corona also clarifies in column 3, lines 39-41, that "the term 'printer' as used herein encompasses various copiers, printers, facsimile receivers and various combinations thereof." Therefore, Corona's

patent pertains to printers in a networked environment, since a printer can only be "shared electronically" in such an environment; physical sharing of the printer among several users, i.e., physically moving the connector from workstation to workstation and installing printer drivers, is clearly not the inferred intention of Corona's patent. Thus Corona's disclosed image forming apparatus and method is "connected to a network to which a plurality of computers are connected in order to enable communication."

With regards to limitation 1, "a storage section which receives and stores ser identification information," Corona states in column 7, lines 33-38, "printer 10 in this system may also print an identifying job banner on the end part 15a of the cover sheet... as shown in FIG 4." The identifying job banner as further described by Corona in column 7, lines 38-44, "can include either or both a printer-user (job generator) identifier and a specific job identifier, such as the subject title and/or date and/or job number of the document, and/or the number of pages, and/or the number of copy sets being made, etc." Since Corona's allowed patent deals specifically with the sorting process of a network printer or other image forming apparatus, he does not expressly include a storage section which receives and stores the user/job identification.

However, examiner puts forward the following arguments: 1.) Because the printer as disclosed by Corona functions in a network environment and specifically cites the existence of user identification data, it is inferred that the user identification data is transmitted across the network and stored in some nonvolatile or volatile memory within the printer. 2.) Printers with nonvolatile or volatile memory for long term or temporary storage of print data and job identifiers are were well known in the art at the time of

submission of the pending application. 3.) Corona incorporates Knodt (US-PAT 5124731) by reference in his patent; Knodt in Figure 2 discloses a disc 56 for storing data within controller section 2 of the given printing system. Therefore, Corona's patent includes a storage section which "receives and stores user identification information for identifying a user of a computer together with printing information from said printer."

With regards to limitation 2, "a sheet counting section which prepares page information from said printing information," this limitation is met by the aforementioned job identifying banner as described in column 7, lines 38-44, "can include either or both a printer-user (job generator) identifier and a specific job identifier, such as the subject title and/or date and/or job number of the document, and/or the number of pages, and/or the number of copy sets being made, etc." The reception of this job identifying banner data as disclosed in the previous paragraph carries out the same functionality of the "sheet counter"; to "prepare page information from said printing information."

Regarding limitation 3, Corona discloses in figure 1 a control means 100, "for selecting which said sheet supply tray will feed copy sheets for a selected job set," as claimed in claim 1. Furthermore, the controller functions to allow for reverse side printing. Corona discloses in column 10, lines 36-41, "if the job sets are being outputted and stacked facedown, another option is to alternatively or additionally print the banners 15a or 16a on their rear sides so that they will still be visible from the top of (facing up in) the stacking tray."

Corona does not expressly disclose printing user and page information on the back of each printed sheet, presumably because this would essentially double the printing time of a given duplex printer.

Microsoft Notepad, which shipped bundled with Microsoft Windows 95 on 8/24/95, prints the page number on each page discharged from the printer output port so that the page number corresponds with the order of the page in the program. This "feature" is also available as an option in several standard word processing or text editor programs, as the method of printing page numbers is well known in the art; the benefit of this feature is to provide the user with a quick and easy way to verify the number of pages printed without the use of a cover page, though the two are not mutually exclusive.

Corona and Microsoft Corporation Notepad are combinable because they both deal with static text representation in the field of printing.

Therefore it would have been obvious at the time of invention to one of normal skill in the art to include in Coronas system, which prints page and user information on the reverse side of banner sheets, a feature to print page and user information on the back of each sheet of corresponding print data as taught by Microsoft Corporation's Notepad application. As stated in item 2, because Corona's invention teaches printing the total page number X, and Microsoft Notepad prints the current page Y, the Corona/Microsoft combination prints "on the back surface of the sheet in Y/X form, wherein X is a total number of pages in a print job, and Y is a page number of the printed sheet."

The motivation of this modification would be to remove the use of banner pages altogether and allowing the user to easily identify the owner and length of documents output face down from a network printer.

Therefore it would have been obvious to combine Corona with Microsoft Corporation Notepad to obtain the invention as disclosed in claims 1, 13, 7, and 19.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert N. Kang whose telephone number is (571) 272-0593. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RNK



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PRIMARY EXAMINER